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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,640	05/31/2000	Jee Loon Look	0630/0G528	4278

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EXAMINER

WALCZAK, DAVID J

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/584,640

Applicant(s)

LOOK ET AL.

Examiner

David J. Walczak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 51-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-13 and 51-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION***Specification***

UP The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter in new claims 51-54 does not have antecedent basis in the specification. Further, in regard to claims 1 and 12, the recitation of the interior wall being substantially smooth does not have antecedent basis in the specification. While the claimed structure appears to be present in the drawings, the claim language must also be present in the detailed description of the invention.

Claim Rejections - 35 USC § 112

Claims 1-13 and 51 -54 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "and retractable" is considered to be new matter and must be deleted from the claims.

Claims 51 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claims 51 and 53, ~~an antecedent basis for "the surface area of the first composition" and "the surface area of the second composition" should be defined.~~

51 - 53 = 52

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 51-~~54~~⁵⁶ are rejected under 35 U.S.C. 103(a) as being unpatentable over Tibbitts in view of Prince. In regard to claims 1, 3, 4, 5 and 12, Tibbitts discloses a lip-stick product 20 comprised of a container 12 having smooth interior walls wherein the product is in sliding contact with the walls and is advanceable and retractable in the container. Although the stick is not disclosed as being formed from two different compositions, attention is directed to the Prince reference, which discloses another lip-stick product wherein the product is formed from a first composition 14 and a second composition 11 which differ in color to form a predetermined multi-color image in order to enable a user to easily apply two different colors of lipstick. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include such a two-composition lip-stick into the Tibbitts container in order to enable a user to easily apply a lipstick having two different colors. In regard to claim 2, the interior and exterior surfaces of the Tibbitts container are different. In regard to claim 6, the image is a ^{ellipse}circle. In regard to claim 7, each cross-section of the stick contains the same image. In regard to claim 8, the stick is used for application. It is noted that the statements of intended use, i.e., for application to an animal, do not lend any patentable

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structure to the claims. In regard to claim 9, the composition is a lip-stick. In regard to claim 10, the composition includes a pharmaceutically acceptable vehicle. In regard to claim 11, the composition comprises a colorant. In regard to claim 13, the Prince stick composition is disclosed as being any preparation to be applied to the surface of a human body for cleaning and conditioning the skin (column 2, lines 40-43). Accordingly, as lip balm is applied to human skin and used for conditioning the lip, the Prince reference anticipates the use of lip balm. In regard to claims 51 and ~~53~~, the surface area of the first composition 14 is substantially different than the surface area of the second composition 11. In regard to claims 52⁵³ and 54, the wall thickness of the first composition 14 is substantially different than the wall thickness of the second composition 11, i.e., at the top portion of the stick, the thickness of composition 14 is greater than the thickness of composition 11 as composition 11 narrows at the top (see Figure 2). Further, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the two compositions in the Prince reference can be designed to have any suitable thicknesses, depending on the needs and desires of the user, without effecting the overall operation of the device.

Response to Arguments

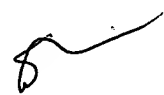
Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new grounds of rejection. Regarding new claims 51-54, the Applicant contends that the Prince reference does not teach the claimed wall thickness, however, as discussed above, Prince discloses such structure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 703-308-0608. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg L. Huson can be reached on 703-308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
March 22, 2002